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| APPLICATION NO.         | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------|-------------|----------------------|---------------------|------------------|
| 10/799,942              | 03/11/2004  | Takamine Aikawa      | 02796/0200992-US0   | 7998             |
| 7278                    | 7590        | 11/01/2005           | EXAMINER            |                  |
| DARBY & DARBY P.C.      |             |                      | ALAVI, ALI          |                  |
| P. O. BOX 5257          |             |                      |                     |                  |
| NEW YORK, NY 10150-5257 |             |                      | ART UNIT            | PAPER NUMBER     |
|                         |             |                      | 2875                |                  |

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |               |  |
|------------------------------|-----------------|---------------|--|
| <b>Office Action Summary</b> | Application No. | Applicant(s)  |  |
|                              | 10/799,942      | AIKAWA ET AL. |  |
|                              | Examiner        | Art Unit      |  |
|                              | Ali Alavi       | 2875          |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/11/04</u> <u>5-7-04</u>   | 6) <input type="checkbox"/> Other: ____                                     |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 6-9, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Shiao (US Pat. No 5,647,623).

Shiao discloses a telescopic flashlight (20, fig.3) that includes a lighting member (50) mounted on the tip of a telescopic arm member having a handling member (11) and is capable of turning on and off the light by a switching operation (fig. 4, col. 4, lines 30-41), comprising: cap-attaching portions respectively formed on the butt end of the handling member and the tip of the lighting member; and a cap member (40) detachably attached to each of the cap-attaching portions, wherein the cap member is allowed to be provided as a cover to be attached to the tip of the lighting member or to be attached to the butt end of the handling member to be housed thereon (fig. 3).

Regarding claim 4, Shiao further discloses that a lens (40) for diffusing or concentrating the light from the lighting member is mounted on the cap member.

Regarding claims 6, Shiao further discloses that the peripheral wall of the cap member is formed of an optically transparency material (col. 2, line 55).

Regarding claim 7, Shiao further discloses that the lighting member comprises: a battery housing part (22) for holding a small-sized battery (30) such as a button type

battery; and an emitter-holding part for holding a light-emitting member that emits light using the small-sized battery as its electric source, where the emitter-holding part is detachably connected to the battery housing part (fig. 3).

Regarding claim 8, Shiao further discloses that a switching structure (fig. 4, col. 30-40) is provided such that a connecting portion such as a screw is formed on the inner peripheral surface or outer peripheral surface of the emitter-holding part and another connecting portion such as a screw that corresponds to the connection portion is formed on the outer peripheral surface or inner peripheral surface of the battery housing part so that a conductor connected to the lighting member is energized when it is brought into contact with the small-sized battery by connecting the emitter-holding part with the battery housing part while the conductor is not energized when it is detached from the small-sized battery by loosing the connection between the emitter-holding part and the battery housing part to slightly move the emitter-holding part away from the battery-housing part (fig. 4).

Regarding claim 9, Shiao further discloses that the external cylindrical part of the telescopic arm member is provided as a handling member (11, fig. 3).

Regarding claim 13, Shiao further discloses that a clip is attached to the handling member (fig. 3).

The telescopic flashlight according to claim 1 the cap member is integrally formed on the lighting member.

Claims 1, 4, 7, 9, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by (JP-3067105).

JP Publication shows a telescopic flashlight (1, fig. 1) that includes a lighting member (34) mounted on the tip of a telescopic arm member (2) having a handling member and is capable of turning on and off the light by a switching operation (push button), comprising: cap-attaching portions (22) respectively formed on the butt end of the handling member and the tip of the lighting member; and a cap member (3) detachably attached to each of the cap-attaching portions, wherein the cap member is allowed to be provided as a cover to be attached to the tip of the lighting member or to be attached to the butt end of the handling member to be housed thereon.

Regarding claim 4, JP Publication further shows 4. The telescopic flashlight according to claim 1, wherein a lens for diffusing or concentrating the light from the lighting member is mounted on the cap member.

Regarding claim 7, JP Publication further shows that the lighting member comprises: a battery housing part for holding a small-sized battery such as a button type battery; and an emitter-holding part for holding a light-emitting member that emits light using the small-sized battery as its electric source, where the emitter-holding part is detachably connected to the battery housing part (fig. 6).

Regarding claim 9, JP Publication further shows that the external cylindrical part of the telescopic arm member is provided as a handling member (fig. 4).

Regarding claim 16, JP Publication further shows that the cap member has an enlarged portion having a tip enlarged like a horn to extend the angle of light (fig. 5).

Claims 1-5, 7, 9-15 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Oya (JP-9237501).

Regarding claim 1, Oya shows a telescopic flashlight (13, fig. 1) that includes a lighting member (14) mounted on the tip of a telescopic arm member (13) having a handling member and is capable of turning on and off (16) the light by a switching operation, comprising: cap-attaching portions (131) respectively formed on the butt end of the handling member and the tip of the lighting member; and a cap member (20) detachably attached to each of the cap-attaching portions, wherein the cap member is allowed to be provided as a cover to be attached to the tip of the lighting member or to be attached to the butt end of the handling member to be housed thereon (fig. 1).

Regarding claim 2, Oya further shows that a generally doughnut-shaped magnet (21a) having an opening for passing light from the lighting member.

Regarding claim 3, Oya further shows that a coloring element to provide the light from the lighting member with color is mounted on the cap member (English abstract).

Regarding claim 4, Oya further shows that a lens for diffusing (20).

Regarding claim 5, Oya further shows an arm member (82) of a retainer for retaining a functional part such as a mirror (83)

Regarding claim 7, Oya further shows that the lighting member comprises: a battery housing part for holding a small-sized battery such as a button type battery; and an emitter-holding part for holding a light-emitting member that emits light using the small-sized battery as its electric source, where the emitter-holding part is detachably connected to the battery housing part (fig. 1).

Regarding claim 9, Oya further shows the external cylindrical part of the telescopic arm member is provided as a handling member (13).

Regarding claim 10, Oya further shows a power-source housing part for housing a power supply such as a battery or a secondary cell is provided on the butt end of the telescopic arm member in a connected row arrangement, and a casing of the power-supply housing part is provided as a handling member (11).

Regarding claim 11, Oya further shows the lighting member is attached to the tip of the telescopic arm member through a joint part (131) and the joint part is able to change the angle of the lighting member in a direction different from the extending direction of the telescopic arm member.

Regarding claim 12, Oya further shows the joint part acts as a spherical surface bearing for each of the tip of the telescopic arm member and the butt end of the lighting member (fig. 1).

Regarding claim 13, Oya further shows a clip (16a) is attached to the handling member.

Regarding claim 14, Oya further shows a retaining part (82) for retaining a mirror (83) having a joint part is provided on the external side of the cap member to allow the angle of the retaining part to be changed.

Regarding claim 15, Oya further shows the joint part is formed of a bearing arm that acts as a spherical surface bearing of each of the tip of the arm member of the cap member and the butt end of the retaining part (fig. 25).

Regarding claim 18, Oya further shows member is integrally formed on the lighting member (fig 1).

***Allowable Subject Matter***

Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wang (US Pat. No. 5,951,142) discloses a telescopic illumination device having a lighting member including a retainer for retaining a mirror, Bliss (Pat. No. 6,565,229) discloses a telescopic flashlight all are cited of interest.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to **Ali Alavi** whose telephone number is **(571) 272-2365**. The examiner can normally be reached between 7:00 A.M. to 5:30 P.M. Tuesday to Friday. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Sandy O'Shea can be reached at (571) 272-2378 or you may fax your inquiry to the **Central Fax at (571) 273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**ALI ALAVI**  
**PRIMARY EXAMINER**